

Application No.: 09/974710

Case No.: 55526US002

Remarks

Claims 1-8, 10-17, 19-22, and 25-60 are pending. Claims 36-52 have been withdrawn from consideration. Claims 1, 22 and 28 are amended.

Applicants note with thanks the Examiner's withdrawal of the objections to the claims, the rejections under 35 USC § 112, second paragraph, and the rejections under 35 USC § 102(b) with respect to Goepfert, Calhoun, Mazurek, Hata, and Sher and the rejections under 35 USC § 103(a) with respect to Goepfert in view of Hata, Goepfert in view of Calhoun, Calhoun in view of Goepfert, Mazurek in view of Hata and Mazurek in view of Sher.

§ 102 Rejections

Claims 1-8, 22, 25, 27 and 52-55 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Patent Number 5,212,011 to Ishikawa et al. ("Ishikawa").

The Examiner states that Ishikawa discloses an article comprising an adhesive layer with a structured surface and a cap layer laminated to the structured surface of the adhesive layer, wherein the exposed surface of the cap layer is unstructured. Claims 1 and 22 have been amended to recite that the structured surface of the adhesive layer is discontinuously in contact with the cap layer. Support for this amendment can be found, for example in Figure 5A, and in the specification at page 5, lines 8-10 of the application as filed. Ishikawa discloses an adhesive continuously in contact with the uneven surface of the base film. Claims 2-8 depend from claim 1 and claims 25 and 27 depend from Claim 22.

Claim 53 recites the cap layer comprises an adhesive having a non-structured exposed surface. The Examiner points to Figure 2. However, Ishikawa fails to teach that the base film #2 is an adhesive layer. Claims 54-55 depend from Claim 53.

The rejection of claims 1-8, 22, 25, 27 and 52-55 under 35 USC § 102(b) as being anticipated by Ishikawa has been overcome.

Claims 1, 3-8, and 21 stand rejected under 35 USC § 102(b) as being anticipated by JP 07-090231 to Sekisui ("Sekisui"). As states above, Claim 1 has been amended. The cap layer and the adhesive layer in Figure 1 of Sekisui are in continuous contact. Claims 3-8 and 21 depend from

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claim 1. The rejection of claims 1, 3-8, and 21 under 35 USC § 102(b) as being anticipated by Sekisui has been overcome.

Claims 1-8, 11, 19, 20, 22, 26-35 and 53-55 stand rejected under 35 USC § 102(b) as being anticipated by WO 99/58620 to Abe ("Abe"). However, Abe fails to disclose a "structured" surface in the adhesive as recited in the present claims. Abe states that the adhesive surface is uneven. Page 2, line 20 of Abe. However, the structured surface of the present invention includes structures with specific shapes. See page 7, lines 9-10 of the application as filed. The rejections of claims 1-8, 11, 19, 20, 22, 26-35 and 53-55 under 35 USC § 102(b) as being anticipated by Abe has been overcome.

§ 103 Rejections

Claims 10, 12, 14 and 15 stand rejected under 35 USC § 103(a) as being unpatentable over Ishikawa in view of Hata (WO 97/33946). Claims 11, 13, 16 and 17 stand rejected under 35 USC § 103(a) as being unpatentable over Ishikawa in view of Sher (US 6,197,397).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. Nothing in Ishikawa would motivate one of skill in the art to modify the adhesive as taught in Hata or Sher. Therefore, no *prima facie* case of obviousness has been made with respect to the rejected claims.

Claims 56-60 stand rejected under 35 USC § 103(a) as being unpatentable over Hata. The Examiner states that making the claims void volumes would be obvious as an optimum range. However, the Examiner has provided no motivation to do so. Therefore, no *prima facie* case of obviousness has been made with respect to the rejected claims.

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In view of the above, it is submitted that the application is in condition for allowance.
Reconsideration of the application is requested.

Respectfully submitted,

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